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EXAMINER	
OUELLETTE, JONATHAN P	

ART UNIT	PAPER NUMBER
3629	

DATE MAILED: 07/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/893,494	BARTON, TIMOTHY	
	Examiner	Art Unit	
	Jonathan Ouellette	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *29 June 2001 and 14 August 2001*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-10* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-10* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *20011002*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. **Claims 5-8 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

The basis of this rejection is set forth in a two-prong test of:

(1) whether the invention is within the technological arts; and

(2) whether the invention produces a useful, concrete, and tangible result.

3. As an initial matter, the United States Constitution under Art. I, §8, cl. 8 gave Congress the power to "[p]romote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries". In carrying out this power, Congress authorized under 35 U.S.C. §101 a grant of a patent to "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition or matter, or any new and useful improvement thereof." Therefore, a fundamental premise is that a patent is a statutorily created vehicle for Congress to confer an exclusive right to the inventors for "inventions" that promote the progress of "science and the useful arts". The phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts". See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). Hence, the first test of whether an

invention is eligible for a patent is to determine if the invention is within the "technological arts".

4. Further, despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable subject matter covered by §101. These exceptions include "laws of nature", "natural phenomena", and "abstract ideas". See *Diamond v. Diehr*, 450, U.S. 175, 185, 209 USPQ (BNA) 1, 7 (1981). However, courts have found that even if an invention incorporates abstract ideas, such as mathematical algorithms, the invention may nevertheless be statutory subject matter if the invention as a whole produces a "useful, concrete and tangible result." See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 149 F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998).

5. This "two prong" test was evident when the Court of Customs and Patent Appeals (CCPA) decided an appeal from the Board of Patent Appeals and Interferences (BPAI). See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). In *Toma*, the court held that the recited mathematical algorithm did not render the claim as a whole non-statutory using the Freeman-Walter-Abele test as applied to *Gottschalk v. Benson,* 409 U.S. 63, 175 USPQ (BNA) 673 (1972). Additionally, the court decided separately on the issue of the "technological arts". The court developed a "technological arts" analysis:

> The "technological" or "useful" arts inquiry must focus on whether the claimed subject matter...is statutory, not on whether the product of the claimed subject matter...is statutory, not on whether the prior art which the claimed subject matter purports to replace...is statutory, and not on whether the claimed subject matter is presently perceived to be an improvement over the prior art, e.g., whether it "enhances" the operation of a machine. *In re Toma* at 857.

6. In *Toma*, the claimed invention was a computer program for translating a source human language (e.g., Russian) into a target human language (e.g., English). The court found that the claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer.

7. The decision in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* never addressed this prong of the test. In *State Street Bank & Trust Co.*, the court found that the "mathematical exception" using the Freeman-Walter-Abele test has little, if any, application to determining the presence of statutory subject matter but rather, statutory subject matter should be based on whether the operation produces a "useful, concrete and tangible result". See *State Street Bank & Trust Co.* at 1374. Furthermore, the court found that there was no "business method exception" since the court decisions that purported to create such exceptions were based on novelty or lack of enablement issues and not on statutory grounds. Therefore, the court held that "[w]hether the patent's claims are too broad to be patentable is not to be judged under §101, but rather under §§102, 103 and 112." See *State Street Bank & Trust Co.* at 1377. Both of these analysis goes towards whether the claimed invention is non-statutory because of the presence of an abstract idea. Indeed, *State Street* abolished the Freeman-Walter-Abele test used in *Toma*. However, State Street never addressed the second part of the analysis, i.e., the "technological arts" test established in *Toma* because the invention in *State Street* (i.e., a computerized system for determining the year-end income, expense, and capital gain or loss for the portfolio) was already determined to be within the technological arts under

the *Toma* test. This dichotomy has been recently acknowledged by the Board of Patent Appeals and Interferences (BPAI) in affirming a §101 rejection finding the claimed invention to be non-statutory. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001).

8. Claims 5-7 appear to be describing a method that is attempting to sell a collection service for candidate-selected candidate profiles, wherein candidate profiles and information regarding the profiles is simply collected. Thus, this process does not include a distinguishable apparatus, computer implementation, or any other incorporated technology, and would appear to be an attempt to patent an abstract idea not a "tangible" process and, therefore, non-statutory subject matter.
9. As to technological arts recited in the preamble, mere recitation in the preamble (i.e., intended or field of use) or mere implication of employing a machine or article of manufacture to perform some or all of the recited steps does not confer statutory subject matter to an otherwise abstract idea unless there is positive recitation in the claim as a whole to breathe life and meaning into the preamble.
10. In the present case, independent Claim 5 mentions a database, however, the claim never explains how or if the data is placed in the database, nor does the claim disclose the further automatic manipulation of the data to advance the underlying process. Claim 6 discloses receiving data from a search query, but never discloses performing automatic manipulation of the data to advance the underlying process.
11. Independent Claim 8 discloses a computer program product (preamble), without the use of a computer to execute the program. Thus, this process does not include a

distinguishable apparatus, computer implementation, or any other incorporated technology, and would appear to be an attempt to patent an abstract idea not a "tangible" process and, therefore, non-statutory subject matter

Claim Rejections - 35 USC § 102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

13. **Claims 3-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Kurzius et al. (US 6,385,620 B1).**

14. As per **independent Claim 3**, Kurzius discloses a system for managing end-to-end an employment recruiting process comprising: a network; at least one web server coupled to said network; a candidate database; a client database; and at least one application server coupled (database server) to said web server (Fig.1 and Fig.3), wherein said at least one application server comprises: a database management system operative to manage said candidate and client databases, and a career management application operative to a manage at least one of a candidate job search and client talent acquisition process form end-to-end (Fig.1; Fig.3, obtain candidate records, obtain job records, filtering and matching).

15. As per Claim 4, Kurzius discloses wherein said career management application comprises *at least one of*: a revenue model including pay for performance; live consultants accessible online to manage the career recruiting process; and application service provider (ASP) offering operative to provide end-to-end human resource outsourcing application services to client human resources departments; *and cross-industry comparable level search capabilities for candidates and clients* (Fig.3; Fig.13; Fig.16, Candidate records matched and ranked against posted job records).

16. As per **independent Claim 5**, Kurzius discloses a method for managing a candidate-selected candidate profile database comprising: receiving candidate resumes (Fig.14a, survey form equivalent to resume) having candidate selected job experience information including selecting at least one of: an industry from a plurality of predefined industries, a job function from a plurality of predefined job functions of said industry, and a job position from a plurality of predefined job positions (Fig.14a, C16 L11-37).

17. As per Claim 6, Kurzius discloses *receiving* comparable cross-industry search queries for candidates' resumes meeting comparable cross-industry criteria (Fig.13; Fig.16, Candidate records matched and ranked against posted job records).

18. As per Claim 7, Kurzius discloses wherein said comparable cross-industry search queries are by *at least one of*: said industry from a plurality of said predefined industries (C3 L59-65, categorizing and indexing job postings and profiles), said job function from said plurality of predefined job functions of said industry, and said job position from a plurality of said predefined job positions (Fig.16, Candidate records matched and ranked against posted job records; C8 L28-40, matching candidates to specified job criteria).

19. As per **independent Claim 8**, Kurzius discloses a computer program product embodied on a computer readable medium with computer program logic stored thereon, said computer program logic for managing a candidate-selected candidate profile database comprising: means for enabling a computer to receive candidate resumes having candidate selected job experience information (Fig.14a, survey form equivalent to resume; C16 L11-37) including: means for enabling the computer to *select at least one of:* a job function from a plurality of a predefined industries, a job function from a plurality of predefined job functions of said industry, and a job position from a plurality of predefined job positions (C2 L8-24, parse qualification data for mapping and matching; C16 L11-37; Fig.14a).

20. As per Claim 9, Kurzius discloses means for enabling the computer to receive comparable cross-industry criteria (C7 L7-22, job posting records).

21. As per Claim 10, Kurzius discloses wherein said comparable cross-industry search queries are *indexed by at least one* of said industry from a plurality of said predefined industries, said job function from said plurality of predefined job functions of said industry, and said job position from a plurality of said job predefined job positions (C3 L59-65, categorizing and indexing job postings).

Claim Rejections - 35 USC § 103

22. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention

was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

23. **Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas (US 2002/0055870 A1) in view of Official Notice.**

24. As per **independent Claim 1**, Thomas discloses a method for providing an online end to end talent acquisition process for managing a client search for a candidate comprising (abstract): (a) facilitating creation of a job requisition for a new job and storing said new job in a job database (Fig.4, job posting; Para 0244 internal and external candidates); (b) receiving and storing in said job database a description of said new job of said job requisition including at least one of an industry, a job function and a job position (Para 0039, create job request); (c) defining a desired candidate for said new job (Para 0040, Para 0042); (d) receiving and executing a cross industry comparable level search query of a plurality of internal candidates for said desired candidate and returning internal candidates (Fig.5 Matching); (e) receiving and executing a cross industry comparable level search query of a plurality of external candidates for said desired candidate and returning external candidates (Fig.5 Matching); (f) facilitating screening said internal and external candidates (Para 0018, Fig.5); (g) facilitating managing selection of least one of said candidates (Figs.5-6, Matching and Selection); (h) facilitating managing an offer and a hire of said at least one of said internal and external candidates (Fig. 6, Selection).

25. Thomas fails to expressly disclose; and (i) facilitating managing an on-board process.

26. However, Official Notice is given that facilitating/managing an on-board process was well known new hire/recruiting processes at the time the invention was made.

27. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included (i) facilitating managing an on-board process, as disclosed by Official Notice in the system disclosed by Thomas, for the advantage of providing a method for providing an online end to end talent acquisition process for managing a client search for a candidate, with the ability to increase the customer service of the employment/recruiting method by including process steps that facilitate the hiring process completely through to job orientation.

28. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kurzius in view of Thomas and further in view of Official Notice.

29. As per **independent Claim 2**, Kurzius discloses a method for providing an online end to end job search and career management process for managing a job search for a candidate (Claims 10 and 14) comprising: (a) facilitating performance of and receiving and storing results of a self assessment of a candidate (Fig.14a, survey form), in a candidate database;(b) facilitating building a resume (profile, C2 L8-24) for said candidate including receiving and storing job experience including *at least one job of* said candidate in said candidate database including for said position *at least one of*: an industry of said job, a job function of said , and a job position of said job (Fig.14a); (d) facilitating researching about clients and a desired job (Fig.7, search jobs); (e) facilitating networking for said candidate with said client for said desired job (Fig.11, presenting candidate record to employer) ; (f) facilitating receiving a cross industry comparable level search query and search said candidate database for said desired job and presenting search results including resulting jobs (Fig.13); (g) facilitating of and selection of at least one

desirable job resulting scoring said job (C10 L44-50, candidate searches for a job – search is scored by comparing search terms and conditions; C11 L15-54; Fig.7).

30. While Kurzius does disclose tracking candidate progress through the employment cycle (to include interviewing), Kurzius fails to expressly disclose (c) facilitating preparing a cover sheet for said resume; (h) facilitating interviewing for said at least one desirable job; (i) facilitating preparing and sending a thank you letter after an interview for said desirable job; (j) facilitating evaluating an offer for said desirable job; (k) facilitating resigning from a prior position; and (l) facilitating managing an on-boarding process.

31. However, Thomas discloses (h) facilitating interviewing for said at least one desirable job, and (j) facilitating evaluating an offer for said desirable job (Fig.6, Selection)

32. Further more, Official Notice is given that facilitating the preparation of a cover sheet for a resume, preparing and sending a thank you letters, resigning from a prior position, and managing an on-boarding process where well known new hire/recruiting processes at the time the invention was made.

33. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included (c) facilitating preparing a cover sheet for said resume; (h) facilitating interviewing for said at least one desirable job; (i) facilitating preparing and sending a thank you letter after an interview for said desirable job; (j) facilitating evaluating an offer for said desirable job; (k) facilitating resigning from a prior position; and (l) facilitating managing an on-boarding process, as disclosed by Thomas and Official Notice, in the system disclosed by Kurzius, for the advantage of providing a method for providing an online end to end job search and career management

process for managing a job search for a candidate, with the ability to increase the customer service of the employment/recruiting method by including process steps that facilitate the hiring process completely through to job orientation.

Conclusion

34. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

35. The following foreign patent is cited to show the best foreign prior art found by the examiner:

Japanese Pat. No. JP 11338879 A to MIYAMOTO et al.

Miyamoto discloses a computer-aided job searching system for employment information service, narrows down search of job offer and displays detailed information about narrow downed job offer based on input individual skill information.

36. The following non-patent literature is cited to show the best non-patent literature prior art found by the examiner:

Piturro, Marlene, "The Power of e-recruiting," Management Review, v89n1, pp: 33-37, January 2000.

Piturro discloses the use of online recruitment techniques to facilitate the hiring process, by companies and recruiters.

37. Additional Literature has been referenced on the attached PTO-892 form, and the Examiner suggests the applicant review these documents before submitting any amendments.

38. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan Ouellette whose telephone number is (571) 272-6807. The examiner can normally be reached on Monday through Thursday, 8am - 5:00pm.

39. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone numbers for the organization where this application or proceeding is assigned (703) 872-9306 for all official communications.

40. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-5484.

June 24, 2005

Jonathan Ouellette
Patent Examiner
Technology Center 3600